

REMARKS

Claims 20-24, 26-32, 34-38 and 40-41 stand rejected and claims 25, 33, and 39 have been objected to as being dependent on a rejected base claim, but otherwise contain allowable subject matter. By this paper, claims 20, 28, 36, and 40 have been amended and claims 42-73 have been added. Accordingly, upon entry of the above amendments claims 20-73 will be pending in the present application. No new matter has been added. Reconsideration and allowance of the claims in light of the amendments and remarks herein are respectfully requested.

Non-Statutory Double-Patenting Rejection

Claims 20, 27, 28, 35, 36, and 41 stand rejected under the judicially created doctrine of double patenting over claims 1 and 9 of U.S. Patent No. 6,317,718. Claim 40 stands objected under 37 C.F.R. 1.75 as being a substantial duplicate of claim 39.

While applicant notes that terminal disclaimer may be filed to overcome this rejection, Applicant respectfully submits that it is premature to do so at this time since none of the pending claims have been indicated to be allowable. If after the entry of the amendments and reconsideration of the application, the examiner concludes that subject matter is allowable except for the double patenting rejection, Applicant may file a terminal disclaimer.

Applicants also note that amended independent claims 20, 28, and 36 are not obvious in light of claims 1 and 9 of U.S. Patent No. 6,317,718. Moreover, claim 40 has been amended so as not to be considered a substantial duplicate of claim 39. Accordingly, applicant respectfully request reconsideration of the double patenting rejection of claims 20, 27, 28, 35, 36, and 41.

Rejection under 35 U.S.C. § 102

Claims 20-23, 26, 28-31, 34, and 36 stand rejected under 35 U.S.C. § 102(e) as anticipated by Bouve *et al.* U.S. Patent No. 5,682,525 (“Bouve”). Bouve fails to disclose all of the limitations of amended claims 20, 28, and 36, and therefore also fails to disclose claims dependent therefrom. Accordingly, reconsideration of the rejection of claims 20-23, 26, 28-31, 34, and 36 in light of the amendments and arguments herein is respectfully requested.

Bouve does not disclose presenting a “customized offer for sale.” In rejecting claim 20, the examiner refers to column 2, lines 26-31, column 3, line 45, and column 11, lines 8-19 and 24-29 of Bouve, as disclosing limitations of claim 20. However, Bouve fails to disclose the limitations of amended claim 20 at those referenced citations, or elsewhere. Bouve does not disclose, *inter alia*, the limitation for receiving the customized offer for sale of an item of merchandise or displaying a customized offer for sale as called for by amended claim 20. Indeed, nowhere in Bouve is it disclosed to display an offer for sale for an item of merchandise that is associated with the item of merchandise that the user desires to purchase, as required by amended claim 20.

Bouve merely discloses “remotely determining the position of a selected category of items of interest in a selected geographic vicinity from a database,” (col. 2, ll. 10-13). The system of Bouve may “generate a map of the geographic vicinity relative to the user and including items of interest.” (col. 11, ll. 9-11). However, ‘items of interest’ are defined as “services, products, geographic sites, architectural sites stores, restaurants, public services, or other items which a user of the invention may wish to locate,” (col. 1, ll. 61-64) and does not include those items for sale or an offer for sale of an item of merchandise. Bouve merely discloses determining a physical location of an item of interest, such as a store, and presenting

the location of that item of interest to the user. Accordingly, Bouve does not disclose or suggest the limitations of amended claim 20.

In rejecting claims 28 and 36, the examiner cites to the same portions of Bouve that purportedly disclose the limitations of 20 as also disclosing similar limitations of claims 28 and 36. Similar to the reasons presented above for claim 20, therefore, Bouve fails to disclose the limitations of amended claims 28 and 36 at those referenced citations, or elsewhere. Indeed, as presented above, Bouve fails to disclose, *inter alia*, presenting a “customized offer for sale,” as recited in claim 28, or “purchasing information including an offer for sale” as recited by claim 36. As discussed above, Bouve discloses merely presenting a physical location of an item of interest, but does not disclose or suggest presenting a customized offer for sale or purchasing information for items of merchandise. ‘Items of interest’ as defined by Bouve, means “services, products, geographic sites, architectural sites stores, restaurants, public services, or other items which a user of the invention may wish to locate,” (col. 1, ll. 61-64), and does not include a “customized offer for sale” or “purchasing information.” Accordingly, as set forth for amended claim 20, Bouve does not disclose or suggest the limitations of amended claims 28 and 36.

For similar reasons, Bouve also fails to disclose the limitations of claims 21-23, 26, 29-31, and 34. Claims 21-23 and 26 depend directly or indirectly from claim 20, claims 29-31 and 34 depend from claim 28, and therefore, similar to the reasons set forth above for claims 20 and 28, Bouve also does not disclose the limitations of claims 21-23, 26, 29-31, and 34. Accordingly, reconsideration of the rejection of claims 20-23, 26, 29-31, and 34 is respectfully requested.

According to the amendments and reasons presented above, claims 20-23, 26, 28-31, 34, and 36 are now in a condition for allowance because Bouve does not independently describe,

either expressly or inherently, each and every element of the amended claims. Accordingly, applicant respectfully request reconsideration and withdrawal of the 35 U.S.C. § 102(e) rejection of claims 20-23, 26, 28-31, 34, and 36 in light of the foregoing.

Rejection under 35 U.S.C. § 103

Claims 24, 32, 37, and 38 stand rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Bouve. With respect to claims 24, 32, and 38, it is the examiner's position that the limitation "displaying a list of items or merchandise available at a retailer and the prices associated therewith . . . is seen to be non-functional descriptive material which will not distinguish the invention from the prior art in terms of patentability." It is also the examiner's position that it would have been obvious to one skilled in the art to display a list of items and the prices to make potential purchases because the subjective interpretation of the data does not patentably distinguish the claimed invention. With respect to claim 37, the examiner has taken official notice that parsing is old and well known to one of ordinary skill in the art and therefore, it would have been obvious to one skilled in the art to parse the input to create a query because this would save time for the recipient of the information. However, as discussed below, applicant submits that Bouve fails to disclose or suggest the limitations of claims 24, 32, 37, and 38. Accordingly, reconsideration of the rejection of claims 24, 32, 37, and 38 in light of the amendments and remarks herein is respectfully requested.

First, claims 24, 32, and 37-38 depend from claims 20, 28, and 36 respectively, and therefore inherit all the limitations of the claims from which they depend. As noted above, Bouve does not disclose or suggest the limitations for amended claims 20, 28, and 36, and therefore, also does not disclose the limitations for claims 24, 32, 37, and 38. Accordingly, reconsideration of the rejection of claims 24, 32, 37, and 38 is respectfully requested.

Second, applicants also submit that characterization that the limitation for a display or displaying “a list of items of merchandise” as “non-functional descriptive material which [does] not distinguish the invention from the prior art,” misstates the limitations of claims 24, 32, and 38. Non-functional descriptive material is “certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, that are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing process performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer.” (emphasis added) MPEP 2106. The limitations of claims 24, 32, and 38 require display of particular items of merchandise and the prices associated therewith, and do not call for merely outputting an arrangement or compilation of facts or data that calls for any further subjective interpretation. Indeed, the functional interrelationship is created by the limitation that the “list” includes items of merchandise available at the retailer and the prices associated. Accordingly, claims 24, 32, and 38 would not have been obvious to one skilled in the art at the time of the invention. Therefore, applicants respectfully request withdrawal of the rejection of claims 24, 32, and 38.

According to the amendments and reasons presented above, claims 24, 32, and 37-38 are now in a condition for allowance because Bouve does not describe or suggest, either singly or in combination with knowledge of one skilled in the art, each and every element of these claims. Accordingly, applicant respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection of claims 24, 32, and 37-38 in light of the foregoing.

Allowable Subject Matter

As discussed above, the prior art does not disclose or suggest the limitations of amended claims 20, 28, and 36, and therefore, also does not disclose the limitations claims dependent therefrom. Therefore, applicant submits that claims 25, 33, and 39 are also in a condition for allowance. Accordingly, reconsideration of the objection to claims 25, 33, and 39 is respectfully requested.

Applicant is grateful for examiner's acknowledgement that claims 25, 33, and 39 contain allowable subject matter and has added new independent claims 42, 49, and 57 which include the limitations of claims 25, 33, and 39 rewritten in independent form including the limitations of the base claims from which they depend. As noted by the examiner, the prior art does not disclose the limitations of claims 25, 33, and 39. Therefore, claims 42, 49, and 57 are in a condition for allowance.

Claims 43-48, 50-56, and 58-61 depend from claims 42, 49, and 57, respectively, and include similar limitations to claims 21-27, 29-35, and 37-41. Accordingly, claims 42-61 are also in a condition for allowance.

New Claims

By this paper, applicant has added new claims 42-73, which describe various embodiments set forth in the specification that are not found, disclosed, or suggested in the prior art. As noted by the examiner, limitations of claims 42-61 are not disclosed by the prior art and contain allowable subject matter. Claims 62-70 each include the limitation for display of an offer for sale, which as described above is not disclosed by the prior art. Claims 71-73 include the limitation for a retailer agent and a shopping agent which are not described or suggested in the prior art. No new matter has been added. Accordingly, new claims 62-73 are also in a

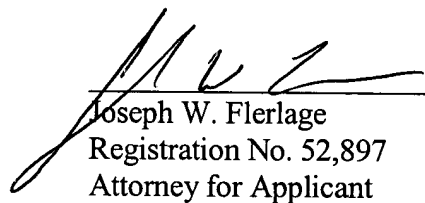
condition for allowance. Applicant, therefore, earnestly solicits consideration of claims 42-73 and allowance thereof.

Conclusion

In view of the amendments and reasons presented herein, withdrawal of the double patenting and the 35 U.S.C. §§ 102 and 103 rejections is respectfully requested and allowance of all pending claims is earnestly solicited. Should the examiner deem a telephone conference to be beneficial in expediting allowance of the application, the examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,

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APPENDIX A

20. (Amended) A method for delivering a customized offer for sale of an item of merchandise from a retailer proximate a user, comprising:

obtaining information identifying [the] an item of merchandise that the user desires to purchase [from the user];

determining a physical location of the user;

querying a computerized network of information utilizing a query based on the information identifying the item of merchandise that the user desires to purchase and the physical location of the user;

receiving from a retailer-based agent in response to the query the customized offer for sale of [the] an item of merchandise that is offered for sale from [the] a retailer proximate the user, the item of merchandise that is offered for sale being associated with the item of merchandise that the user desires to purchase; and

displaying the customized offer and a physical location of the retailer.

28. (Amended) An apparatus that delivers a customized offer for sale of an item of merchandise from a retailer proximate a user, comprising:

a processor;

memory that stores information under the control of the processor;

logic that obtains information identifying [the] an item of merchandise [from] that the user desires to purchase;

logic that determines a physical location of the user;

logic that queries a computerized network of information utilizing a query based on the information identifying the item of merchandise that the user desires to purchase and the physical location of the user;

logic that receives the customized offer for sale of [the] an item of merchandise from a retailer-based agent in response to the query, the item of merchandise being offered for sale at a retailer proximate the user and being associated with the item of merchandise that the user desires to purchase; and

logic that displays the customized offer and a physical location of the retailer.

36. (Amended) A method for delivering purchasing information for sale of an item of merchandise from a retailer proximate a user, comprising:
obtaining information identifying [the] an item of merchandise [from] that the user desires to purchase;
determining a physical location of the user;
automatically querying a computerized network of information utilizing a query based on the item information and the physical location of the user;
receiving the purchasing information from an agent in response to the query, the purchasing information including an offer for sale of an item of merchandise being associated with the item of merchandise that the user desires to purchase; and
displaying the purchasing information.

40. (Amended) The method of claim [36] 39, further comprising recognizing patterns to enhance determining the closest retailers surrounding the user, and suggesting items of merchandise for sale at the closest retailers surrounding the user.